

REMARKS/ARGUMENTS

The Examiner has delineated the following invention as being patentably distinct.

Group 1: Claim(s) 1-29, drawn to a method of incorporating a mark of origin or fingerprint in a CVD single crystal diamond material;

Group 2: Claim(s) 30-53, drawn to a CVD single crystal diamond material bearing a mark of origin or fingerprint;

Group 3: Claim(s) 54-73, drawn to an apparatus for detecting a mark of origin or fingerprint in a CVD single crystal diamond material bearing a mark of origin or fingerprint; and

Group 4: Claim(s) 74 drawn to a method of viewing or detecting a mark of origin or fingerprint in a CVD single crystal diamond material.

Applicants provisionally elect with traverse the invention of Group 2 (Claims 30-53) drawn to a CVD single crystal diamond material bearing a mark of origin or fingerprint.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. §803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are independent or patentably distinct.

The claims of Groups 1-4 are directed to a process, product, and apparatus, and as such are considered to be interdependent and should be examined together on the merits, especially wherein the sole disclosed utility is that recited in the specification, the claims of Groups 1, 3 and 4 further define the invention of Group 2. There is a commonality that exists between the Groups. It is a technical relationship that involves the same feature, and it is this technical feature that defines the contribution which each of the Groups, taken as a whole makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility.

Products, method of making and the means by which the method is performed (apparatus) are considered related inventions under 37 C.F.R. § 1.475(b) and unity of invention between the groups exists.

Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

Further, M.P.E.P. §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits even though it includes claims to distinct and independent inventions.

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction requirement should now be required when the International Preliminary Report did not, the restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that a “national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to ...(3) a product, process especially adapted for the manufacture of said product.” In the instant application, claims 1-29 are directed to a method while claims 30-53 are directed to a product.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants further request that if Group 2 is found allowable, withdrawn groups 1, 3 and 4 which include the limitations of the allowable claims is rejoined.


Respectfully submitted,

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